

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

TALECRIS BIOTHERAPEUTICS, INC., and)
BAYER HEALTHCARE LLC,)

Plaintiffs,)

v.)

BAXTER INTERNATIONAL INC., and)
BAXTER HEALTHCARE CORPORATION,)

Defendants.)

C.A. No. 05-349-GMS

Jury Trial Demanded

REDACTED VERSION DI 262

BAXTER HEALTHCARE CORPORATION,)

Counterclaimant,)

v.)

TALECRIS BIOTHERAPEUTICS, INC., and)
BAYER HEALTHCARE LLC,)

Counterdefendants.)

PLAINTIFFS' MEMORANDUM OF LAW IN SUPPORT OF THEIR
MOTION *IN LIMINE* NO. 5 TO PRECLUDE CERTAIN
EXPERT TESTIMONY OF THOMAS J. KINDT, Ph.D.

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Redacted Version Filed: April 30, 2007
Date: April 23, 2007

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INTRODUCTION

Plaintiffs and Counterclaim Defendants Talecris Biotherapeutics, Inc. and Bayer Healthcare LLC (collectively, "Plaintiffs") hereby move *in limine* pursuant to Federal Rule of Evidence 702 to preclude Defendants Baxter International Inc. and Baxter Healthcare Corporation (collectively, "Baxter") from calling Dr. Thomas J. Kindt as a witness at trial to provide: (1) expert opinions on inherency, because he admitted that solvent detergent treatment does not inherently elevate ACA; (2) expert opinions on obviousness, as his analysis was based on improper hindsight; and (3) testimony on invalidity that relies on prior art that was not disclosed in deposition exhibits TAL 246 or TAL 262.

LEGAL STANDARDS AND ARGUMENT

Dr. Kindt's opinions are inadmissible because they are irrelevant and unreliable pursuant to Federal Rule of Evidence 702 which provides:

If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.

Fed. R. Evid. 702. Under Rule 702, this Court acts as a "gatekeeper" through a preliminary determination that the proffered evidence is both relevant and reliable. *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 147-49 (1999).

1. The Court should exclude any opinions related to inherency because Dr. Kindt admitted that solvent detergent treatment does not inherently elevate ACA.

In his expert report, Dr. Kindt opined that the claims of United States Patent No. 6,686,191 ("the '191 patent") were both anticipated and obvious. A critical element of these defenses is based on the assumption that solvent detergent treatments inherently elevate ACA.

(Mason Dec.¹ Ex. 8 at 31-41.) For support, in his expert report Dr. Kindt relied on language from the Board of Patent Appeals and Interferences (“Board”), the ‘191 patent, and the prosecution history taken out of context. (*Id.*) But in his deposition Dr. Kindt admitted that solvent/detergent treatment does not inherently elevate ACA. Dr. Kindt testified:

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(Mason Dec. Ex. 9 at 151:20-152:3; *see also id.* at 155:1-5.) Further, neither Baxter nor any of its witnesses or experts has ever opined that all solvent detergent treatments inherently elevate ACA. In fact, several witnesses testified that inherency had not been determined in this case because many of the solvent detergent combinations known to the person of ordinary skill in the art had never even been evaluated for their effect on ACA. (*See, e.g.*, Mason Dec. Ex. 11 at 20:4-12.) Dr. Kindt should therefore be precluded from providing any testimony that all solvent detergent treatments inherently elevate ACA, as his deposition testimony is in direct conflict with his expert report. As such, the opinions offered in his report are not based on sufficient facts or data, rendering them unreliable.

2. The Court should exclude any opinions related to the obviousness of the ‘191 patent, due to the improper legal standard used by Dr. Kindt.

In his expert report, Dr. Kindt opined that the ‘191 patent was invalid as obvious over a combination of references. (Mason Dec. Ex. 8 at 30-56.) During his deposition, Dr. Kindt

¹ The “Mason Dec.” is the Declaration of Jaclyn M. Mason in Support of Plaintiffs’ Motions *in Limine* Nos. 1-5, filed concurrently herewith.

explicitly admitted that he used hindsight reconstruction to perform his obviousness analysis. Dr. Kindt testified that

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(Mason Dec. Ex. 9 at 244:1-10; *see also* 242-244.) Such hindsight analysis is improper. The Federal Circuit has clearly stated in numerous cases that the “determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998); *see also In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) (“It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.”). Dr. Kindt should therefore be precluded from providing any testimony related to the obviousness of the ‘191 patent, as it is legally corrupt, unreliable, and highly likely to confuse the jury when the Court instructs them on the proper law regarding obviousness.

3. The Court should exclude all opinions based on prior art not listed in Exhibits TAL 246 and TAL 262.

In his expert report, Dr. Kindt opined that the claims of the ‘191 patent were invalid because they were obvious in light of numerous prior art references. (Mason Dec. Ex. 8 at 30-56.) Due to the large number of references cited, and literally hundreds of possible combinations and permutations, Plaintiffs provided Dr. Kindt with blank paper during his deposition and requested that he list all prior art combinations that formed the basis for his opinion that claims of the ‘191 patent are obvious. Dr. Kindt testified that

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(Mason Dec. Ex. 9 at 204:18-205:1, 244:13-245:7.) Dr. Kindt should therefore be precluded from providing any

testimony that relies on any combination of references other than those listed in TAL 246 for claim 1 and TAL 262 for claim 7. (See Mason Dec. Exs. 12-13.)

CONCLUSION

For these reasons, Plaintiffs respectfully request that the Court grant their motion *in limine* to exclude the following testimony of Dr. Kindt: (1) expert opinions on inherency, because he admitted that solvent detergent treatment does not inherently elevate ACA; (2) expert opinions on obviousness, as his analysis was based on improper hindsight; and (3) testimony on invalidity that relies on prior art that was not disclosed in exhibits TAL 246 or TAL 262.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify on this 23rd day of April, 2007 I electronically filed the foregoing **Plaintiffs' Memorandum of Law in Support of Their Motion *In Limine* No. 5 to Preclude Certain Expert Testimony of Thomas J. Kindt, Ph.D.** with the Clerk of Court using CM/ECF which will send notification of such filing to the following:

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I also hereby certify that a true copy of the foregoing document was served upon the following in the manner indicated on April 23, 2007.

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